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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ERIC T. LAMBERT,
JOHN S. MARESCA, and
MICHAEL J. WHITNEY

Appeal 2009-003903
Application 09/751,585
Technology Center 3600

Decided: February 23, 2010

Before HUBERT C. LORIN, BIBHU R. MOHANTY, and
JEFFREY R. FREDMAN, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Eric T. Lambert, et al. (Appellants) seek our review under 35 U.S.C. § 134 (2002) of the final rejection of claims 40-71. Claims 1-39 have been cancelled. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We AFFIRM-IN-PART.¹

THE INVENTION

This invention is “a method, system and storage medium for facilitating part qualification functions in a communications network environment.” Specification 2:14-16.

Claim 40. A method for facilitating part qualification functions in a communications network environment, comprising:

creating a commodity template for a commodity, said commodity associated with a supplier part, comprising:

entering requirements data for qualifying said commodity;

selecting at least one database in a part qualification repository for storing said requirements data, said part qualification repository comprising:

a parts database receiving information from a commercial parts database;

a technology survey database;

a quality information network database;

an archives database; and

¹ Our decision will make reference to the Appellants’ Appeal Brief (“App. Br.,” filed Oct. 18, 2006) and Reply Brief (“Reply Br.,” filed Sep. 10, 2008), and the Examiner’s Answer (“Answer,” mailed Jul. 10, 2008).

a system testing database;
assigning a default viewing tool for qualifying said
commodity based upon said at least one database selected,
establishing access restrictions operable for restricting
and authorizing viewing and editing capabilities associated with
said commodity template;
wherein said requirements data stored in databases
associated with said part qualification repository are shared
among said databases.

THE REJECTIONS

The Examiner relies upon the following as evidence of
unpatentability:

Ferriter	US 5,109,337	Apr. 28, 1992
Aycock	US 5,765,138	Jun. 9, 1998
Ensel	US 6,493,685 B1	Dec. 10, 2002
Weinberger	US 6,813,777 B1	Nov. 2, 2004

The Examiner took “Official Notice” that databases such as a
technology survey database, a quality information network database, an
archive database, and a systems database are common in the art.
[Hereinafter Official Notice I.]

The Examiner took “Official Notice” that “access restrictions are
common in the art.” [Hereinafter Official Notice II.]

The Examiner took “Official Notice” that “status boxes are common
in the art.” [Hereinafter Official Notice III.]

The following rejections are before us for review:

1. Claims 40, 45-50, 57-62, and 67-71 are rejected under 35 U.S.C. §103(a) as being unpatentable over Ferriter, Ensle, Official Notice I, and Official Notice II.
2. Claims 41-44, 51-56, and 63-66 are rejected under 35 U.S.C. §103(a) as being unpatentable over Ferriter, Ensle, Official Notice I, and Official Notice II, and Aycock.
3. Claims 41-44, 51-56, and 63-66 are rejected under 35 U.S.C. §103(a) as being unpatentable over Ferriter, Ensle, Aycock, Official Notice I, Official Notice II, Official Notice III and Weinberger.

ISSUES

The first issue is whether the Appellants have established that the Examiner erred in rejecting claims 40, 45-50, 57-62, and 67-71 under 35 U.S.C. §103(a) as unpatentable over Ferriter, Ensle, Official Notice I, and Official Notice II.

The second issue is whether the Appellants have established that the Examiner erred in rejecting claims 41-44, 51-56, and 63-66 under 35 U.S.C. §103(a) as being unpatentable over Ferriter, Ensle, Official Notice I, Official Notice II, and Aycock.

The third issue is whether the Appellants have established that the Examiner erred in rejecting claims 41-44, 51-56, and 63-66 under 35 U.S.C. §103(a) as unpatentable over Ferriter, Ensle, Aycock, Official Notice I, Official Notice II, Official Notice III and Weinberger.

FINDINGS OF FACT

We find that the following enumerated findings of fact (FF) are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

The scope and content of the prior art

Ferriter

1. Ferriter describes a system for designing a hardware product. Col. 2, ll. 27-29.
2. Ferriter states, “[b]ased on the data input by the user, the system then generates a qualified parts list . . .” Ferriter: Abstract.
3. Ferriter states “DB2 is a relational database management system, but it will be understood by those skilled in the art that other databases, including hierarchical databases, could be used.” Col. 3, l. 66 – col. 4, l. 1.
4. Ferriter describes a design tool that is implemented in software. Col. 5, l. 66 - col. 5, l. 68.
5. Ferriter describes that when a user selects an inputted component, the system provides a pop-up panel for manufacturing details. *See* col. 6, ll. 13-14.
6. Ferriter’s Figures 3 and 4 depict a screen showing the pop-up panel for the manufacturing details. Col. 3, ll. 39-44 and Figs. 3 - 4.
7. Ferriter’s Figure 2 depicts a computer display of a hierarchical tree structure. Col. 2, ll. 36-38 and Fig. 2.
8. Ferriter states:

In this example, the designer intends to use an “off the shelf” battery to be purchased complete from Sears. . . . The user can then choose to have default values supplied from the relational database based on known item attributes. The user selects the action “DEFAULT”, and the screen shown in Fig. 4 is displayed. The method by which the relational database can access these defaults is by accessing the table in which the user input data was captured during the query session. More specifically, the attributes in the table are accessed by attribute numbers and these numbers, in turn are used as an index to access the default attributes for items, these values having been previously stored for similar parts in the database.

Ferriter col. 5, ll. 36-51.

9. Ferriter’s claim 1 includes a step of “accessing a database to insert default manufacturing information in said screen from said database for similar items” (Col. 8, ll. 64-66) and a step of “generating an item number for each item and storing the manufacturing information input to said screen in a database indexed by said item number. (Col. 9, ll. 4-6).”

Aycock

10. Aycock describes a method of “evaluating supplier capabilities to qualify a supplier as a vendor for a product.” Col. 2, ll. 58-60.

Ensel

11. Ensel describes a system for presenting electronic bills to consumers and for processing consumer payments. Col. 1, ll. 8-10.
12. Ensel describes a database server 202 having multiple databases: Enrollment file 205, Bill Summary file 210, an E-Bill file 215,

which contains current and historical data related to E-Bills; A Template file 200; Payment file 225; Inquiry file 230; and an Insert file 235. Col. 10, ll. 5-20.

Weinberger

13. Weinberger describes a passenger entertainment system to provide passenger entertainment services on-board a vehicle and communication services between passengers and people off-board a vehicle. Col. 4, ll. 20-29.
14. Weinberger describes displaying phone call status on a passenger seat screen. Col. 43, ll. 14-18.

PRINCIPLES OF LAW

Obviousness

Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

KSR Int’l Co. v. Teleflex Inc., 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 550 U.S. at 407 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”) The Court in *Graham* further noted that evidence of

secondary considerations “might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.” *Graham*, 383 U.S. at 17-18.

ANALYSIS

The rejection of claims 40, 45-50, 57-62, and 67-71 under §103(a) as being unpatentable over Ferriter, Ensel, Official Notice I, and Official Notice II.

The Appellants argue claims 40, 45-50, 57-62, and 67-71 as a group App. Br. 7-9. We select claim 40 as the representative claim for this group, and the remaining claims 45-50, 57-62, and 67-71 stand or fall with claim 40. 37 C.F.R. § 41.37(c)(1)(vii) (2009).

The Appellants argue: 1) that Ferriter does not teach a parts database “receiving information from a commercial parts database” (App. Br. 8); 2) that Ferriter does not teach a technology survey database, a quality information network database, an archive database, and a system database and that the Examiner use of Official Notice that such database are common in the art was improper (App. Br. 8-9); 3) that Ferriter does not teach “assigning a default viewing tool for qualifying the commodity based upon the database selected” (App. Br. 9); 4) that neither Ferriter nor Ensel teaches “sharing requirements information with multiple databases” (App. Br. 9); and 5) that neither Ferriter nor Ensel teach establishing access restrictions (App. Br. 9).

Appellants have the burden on appeal to the Board to demonstrate error in the Examiner’s position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) (“On appeal to the Board, an applicant can overcome a

rejection [under § 103] by showing insufficient evidence of prima facie obviousness or by rebutting the prima facie case with evidence of secondary indicia of nonobviousness.”) (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

Before, turning to address Appellants’ specific arguments, we note that most of the Appellants arguments seem to relate to the Appellants’ assertion that Ferriter does not teach qualifying parts. For example, the Appellants argue that “Ferriter does not teach or recite qualifying parts, [and] neither the requirements data nor the databases . . . which are used to qualify parts. . .” App. Br. 8. However, claim 40 does not recite a method of qualifying parts nor does it include a step of using the requirements data or databases to qualify parts. Claim 40 recites “a method for *facilitating* part qualification” (emphasis added) and recites steps related to the creation of a template of data in a database. Claim 40 also recites, for example, “entering requirements data for qualifying said commodity.” However, the “for qualifying said commodity” is a statement of the function of the data and not a recitation of a step. *Cf. In re Schreiber*, 128 F.3d 1473, 1477-78 (Fed. Cir. 1997) (functional language does not confer patentability if prior art structure has capability of functioning in the same manner). We note that Ferriter states, “[b]ased on the data input by the user, the system then generates a *qualified* parts list . . .” Ferriter Abstract (emphasis added). Claim 40 does not recites limitations that require a step of qualifying the parts.

Now, turning to the Appellants’ first argument, the Appellants argue that even if database 10 of Ferriter is considered to teach the claimed part qualification repository comprising a parts database, the database of Ferriter does not receive information from a commercial parts database. App. Br. 8.

Thus the Appellants argue Ferriter does not teach the claimed limitation of “a parts database receiving information from a commercial parts database.” *Id.* The Examiner does not specifically respond to this argument. *See* Answer 8.

We note that the Specification does not expressly define “commercial parts database” and find that the term encompasses any database containing commercial parts information. Ferriter describes accessing a database to insert default manufacturing information into a manufacturing details screen for a component of a product and storing the information in a database. FF 9. Ferriter provides an example where default manufacturing information is accessed for a commercially available battery. FF 8. We find that this description teaches receiving information from a commercial parts database.

Accordingly, we find that the Appellants have not shown that the Examiner erred because Ferriter does not teach a parts database receiving information from a commercial parts database.

Turning to the Appellants’ second argument, the Appellants argue that the Examiner has improperly taken Official Notice that databases such as a technology survey database, a quality information network database, an archive database, and a systems database are common in the art (Official Notice I). App. Br. 8-9. The Appellants assert that Official Notice I is not capable of instant and unquestionable demonstration as being well known. App. Br. 9.

However, the Appellants’ arguments do not appear to traverse what Examiner regards as knowledge that would have been generally available to one of ordinary skill in the art at the time the invention was made. Even if one were to interpret Appellants’ arguments and comments as constituting a

traverse, Appellants' arguments and comments do not appear to constitute an adequate traverse because Appellants have not specifically pointed out the supposed errors in the Examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. 27 CFR 1.104(d)(2), MPEP 707.07(a). An adequate traverse must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying Examiner's notice of what is well known to one of ordinary skill in the art. *In re Boon*, 439 F.2d 724, 728 (CCPA 1971).

We note that that the Appellants do not challenge the Examiner's combination of the Ferriter, Aycock, and Official Notice I, but only argues that the Examiner has improperly taken Official Notice. *See* App. Br. 8-9. Accordingly, we find that the Appellants have not shown that the Examiner erred by taking official notice.

Turning to the Appellants' third argument, the Appellants argue that Ferriter does not teach the step of "assigning a default viewing tool for qualifying the commodity based upon the database selected" because "[f]igures 2-4 of the Ferriter reference simply illustrate computer screen displays of hierarchical product structures designed by a user." App. Br. 9. The Examiner does not respond to this argument (*see* Answer 10-8) but does point to Figure 2-4 in the rejection to teach this limitation (Answer 4).

While Figure 2 of Ferriter does show a computer screen illustrating a hierarchical product structure (FF 7), in Figure 3, Ferriter depicts a screen that is used to input manufacturing information for a component, and, in Figure 4, Ferriter depicts a screen where default values are supplied for the manufacturing information for the component. FF 6. Further, Ferriter

teaches that these screens are part of a conceptual design tool that is implemented in software. FF 4-6. We find that when the design tool is implemented in software by programming, the screen is “assigned.” The Appellants do not provide any arguments as to why Ferriter’s teaching of programming the screens, depicted in Figures 3 and 4, into software does not teach the step of “assigning a default viewing tool for qualifying said commodity based upon said at least one database selected.”

Accordingly, we find that the Appellants have not shown that the Examiner erred because Ferriter does not teach assigning a default viewing tool for qualifying the commodity based upon the database selected.

Turning to the Appellants’ fourth argument, the Appellants argue that neither Ferriter nor Ensel teaches “sharing requirements information with multiple databases.” App. Br. 9. Specifically, the Appellants seem to argue that Ensel does not teach requirements information since it is directed to a billing and a payment application. *Id.*

However, the Examiner found that Ferriter teaches requirements data for qualifying a commodity (Answer 4) and that Ensel teaches sharing data among multiple databases (Answer 5 and FF 11-12). The Examiner found that combining Ferriter and Ensel “to share data between databases to disseminate data to various entities would be obvious to one of ordinary skill in the art.” *Id.* The Appellants’ argument does not address the Examiner’s combination of Ferriter and Ensel. The Appellants do not argue that the Examiner’s combination fails to teach sharing data among multiple databases.

Accordingly, we find that that the Appellants have not shown that the Examiner erred because Ferriter does not teach sharing requirements information with multiple databases.

Finally, turning to the Appellants' fifth argument, the Appellants merely assert that "neither Ferriter nor Ensel recite establishing access restrictions as provided in Appellants' claims 40, 50, and 62." App. Br. 9.

The Examiner took official notice that access restrictions are common in the art (Official Notice II) and concluded that it would have been obvious "to employ access restrictions to prevent unauthorized users from viewing the data." Answer 5. The Appellants have not traversed Official Notice II and do not argue that the Examiner's combination fails to teach sharing data among multiple databases.

"It is not the function of this court to examine the claims in greater detail than argued by an appellant, looking for nonobvious distinctions over the prior art." *In re Baxter Travenol Labs*, 952 F.2d 388, 391 (Fed. Cir. 1991). See also *In re Wiseman*, 596 F.2d 1019, 1022 (CCPA 1979) (arguments must first be presented to the board). A general allegation that the art does not teach any of the claim limitations is no more than merely pointing out the claim limitations. A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim. 37 C.F.R. § 41.37(c)(1)(vii) (2009).

Accordingly, we find that the Appellants have not shown that the Examiner erred because "neither Ferriter nor Ensel recite establishing access restrictions."

We find that the Appellants have not shown that the Examiner erred in rejecting claims 40, 45-50, 57-62, and 67-71 under §103(a) as being unpatentable over Ferriter and Ensel.

The rejection of claims 41-44, 51-56, and 63-66 under §103(a) as being unpatentable over Ferriter, Ensel, Official Notice I, Official Notice II, and Aycock.

First, the Appellants argue claims 41-43, 51-53, 56, and 63-65 as a group. App. Br. 10. We select claim 41 as the representative claim for this group, and the remaining claims 42-43, 51-53, 56, and 63-65 stand or fall with claim 41. 37 C.F.R. § 41.37(c)(1)(vii) (2009).

The Appellants argue:

[t]he qualification of the Appellants invention, on the other hand, qualifies technologies and supplier parts according to a related commodity type, which is not taught or suggested by Aycock. Accordingly, not all of the elements provided in claims 41 and 63 are taught or suggested by Ferriter, Ensel, and Aycock, either alone or in combination.

App. Br. 10.

The Appellants do not specifically point to which claim limitations of claims 41 or 63 that the Appellants assert are not taught or suggested by Ferriter, Ensel, and Aycock and, as discussed above, claim 40, from which claim 41 depends, does not include a step of qualifying parts nor does it include a step of qualifying technologies. Dependent claim 41 also does not recite a step of qualifying parts but merely further limits the commodity template.

Accordingly, we find that the Appellants have not shown that the Examiner erred in rejecting claims 41-43, 51-53, 56, and 63-65 under §103(a) as unpatentable over Ferriter, Ensel, and Aycock.

Second, we reverse the rejection of claims 44, 54, 55, and 66 under §103(a) over Ferriter, Ensel, Official Notice I, Official Notice II, and Aycock.

In the Answer the Examiner added a new ground of rejection over claims 41, 44, 51-56, and 63-66 under §103(a) over Ferriter, Ensel, Official Notice I, Official Notice II, Aycock, Official Notice III, and Weinberger admitting that Ferriter, Ensel, Official Notice I, Official Notice II, and Aycock do not teach “status boxes.” Answer 4. Since “status boxes” are required in claims 44, 54, 55, and 66, we reverse the rejection of these claims under §103(a) over Ferriter, Ensel, Official Notice I, Official Notice II, and Aycock.

The rejection of claims 41-44, 51-56, and 63-66 under §103(a) as being unpatentable over Ferriter, Ensel, Official Notice I, Official Notice II, Aycock, Official Notice III, and Weinberger.

The Examiner added the rejection of claim 41-44, 51-56, and 63-66 under Ferriter, Ensel, Aycock, Official Notice I, Official Notice II and Weinberger as a new ground of rejection in the Answer. Answer 7. In the rejection, the Examiner states “status boxes are common in the art.” Answer 7. The Examiner then cites Weinberger as evidence that status boxes are common in the art but provides no citation to where in Weinberger status boxes are disclosed. Answer 7. The Examiner concludes that to provide

status boxes for Ferriter, Ensel or Aycock would have been obvious in view of the common knowledge and/or Weinberger. Answer 7.

In response to the Examiner's rejection, the Appellants argue that Weinberger does not teach a status box to indicate approval status in a parts qualifying database. Reply Br. 2. The Examiner does not respond to the Appellants argument. *See* Answer 10-8.

While we find that Weinberger does describe displaying the status of a phone call on a passenger seat screen (FF 14-15), the Examiner has not pointed to this disclosure nor provided any explanation with logical underpinnings as to whether one of ordinary skill in the art would have been led by this disclosure to provide a status screen including a status box indicating approval in the Examiner's proposed combination of Ferriter, Ensel, Official Notice I, Official Notice II, and Aycock. "[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR.*, 550 U.S. at 418 (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

Therefore, we find that the Examiner has not established a *prima facie* showing that one of ordinary skill in the art would have been led by Ferriter, Ensel, Aycock, Official Notice I, Official Notice II and Weinberger to a status screen including a status box indicating approval status.

We note that status boxes are only recited in dependent claims 44, 54, and 66. Accordingly, we find that the Appellants have shown that the Examiner erred in rejecting claims 44, 54, and 66, and claim 55 dependent upon claim 54, under Ferriter, Ensel, Official Notice I, Official Notice II, Aycock, Official Notice III, and Weinberger.

However, we affirm the rejection of claims 41-43, 51-53, 56, and 63-65 since the Appellants argument with respect to this ground of rejection is directed to a limitation not recited by these claims.

CONCLUSIONS OF LAW

We conclude that the Appellants have not shown that the Examiner erred in rejecting:

claims 40, 45-50, 57-62, and 67-71 under 35 U.S.C. § 103(a) as being unpatentable over Ferriter, Ensel, Official Notice I, and Official Notice II

claims 41-43, 51-53, 56, and 63-65 under 35 U.S.C. § 103(a) as being unpatentable over Ferriter, Ensel, Official Notice I, and Official Notice II, and Aycock; and

claims 41-43, 51-53, 56, and 63-65 under 35 U.S.C. § 103(a) as being unpatentable over Ferriter, Ensel, Official Notice I, Official Notice II, Aycock, Official Notice II, and Weinberger.

We conclude that the Appellants have shown that the Examiner erred in rejecting claims 44, 54, 55, and 66 under 35 U.S.C. § 103(a) as being unpatentable over Ferriter, Ensel, Official Notice I, and Official Notice II, and Aycock and under § 103(a) as unpatentable over Ferriter, Ensel, Official Notice I, Official Notice II, Aycock, Official Notice III, and Weinberger.

DECISION

The decision of the Examiner to reject claims 40-43, 45-53, 56-65, 67-71 is affirmed.

The decision of the Examiner to reject claims 44, 54, 55, and 66 is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED-IN-PART

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